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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/665,643   | 09/19/2003  | Jeffrey J. Young     | 81230.96US1         | 6110             |
| 34018  | 7590        | 11/28/2006           | EXAMINER            |                  |
| GREENBERG TRAURIG, LLP<br>77 WEST WACKER DRIVE<br>SUITE 2500<br>CHICAGO, IL 60601-1732 |             |                      | YACOB, SISAY        |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2612                |                  |

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/665,643

Applicant(s)

YOUNG, JEFFREY J.

Examiner

Sisay Yacob

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 8-14, 17 and 20-26 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 6, 7, 15, 16, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1 This communication is in response to applicant's pre-appeal brief request, which is filed on August 15, 2006.

Claims 1-26 are pending.

2 In view of the argument filed on August 15, 2006, **PROSECUTION IS HEREBY REOPENED**. A new ground of rejection is set forth below.

3 To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

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### Response to Arguments

4 Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

### Rejections - 35 USC § 103

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6 The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7 Claims 1, 8-13 and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owner's Manual: 8-IN-1 UNIVERSAL REMOTE CONTROL (hereinafter "Manual") in view of News & Press Releases: News Toshiba

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Launches First Notebook with Full Remote Control Multimedia Capabilities

(hereinafter "Toshiba").

8 As to claims 1 and 13, the Manual discloses a method, a readable medium having instructions for presenting a size of a writeable memory within a universal remote control (Page 2), comprising within the universal remote control which measures a writeable memory, and using the universal remote control to present an indication of the size of the writeable memory **(When writeable memory is available (memory size is greater than 0), there is no indication on the display, so a user can keep programming the remote control. When the remote control displays "full" (memory size is 0), which is an indication as to the size of the writeable memory; See page 11, paragraph 4).** However, the Manual does not expressly disclose a method for invoking a diagnostic routine. Toshiba discloses a notebook with a full remote control multimedia capabilities (Page 1, paragraph 1 and 3; Page 2, Satellite 5100-A741 Product Specifications), it is inherent property of a notebook (computer) to have a diagnostic routine to measure a size of a writable memory **(the user can invoke the diagnostic routine by right clicking on the property icon of the notebook, the user can access the see the overall, occupied, and available memory of the notebook).**

It would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify the method for presenting a size of a writeable memory within a universal remote control of the Manual, by incorporating the diagnostic

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routine for measuring the writable memory, in order to have a method and a readable medium having instructions for presenting a size of a writeable memory within a universal remote control comprising invoking a diagnostic routine within the universal remote control which measures a size of the writeable memory, and using the universal remote control to present an indication of the size of the writeable memory as measured by the diagnostic routine, because the Manual discloses a method for indicating the availability of a writeable memory within a universal remote control and Toshiba discloses a notebook with a full remote control multimedia capabilities that incorporates a diagnostic routine to measure a size of a writeable memory. And one skilled in the art would have been motivated, to combine these in order to make the indication of available writeable memory readily available to the user.

9 As to claims 8 and 20, the readable medium and method as recited in claims 1 and 13, further, Manual discloses the measured memory size is displayed in an alphanumeric display of the universal remote control (Page 11, Paragraph 4). Also, it is well known and widely used in the notebook (computer) art to measure an overall size of the writeable memory and have alphanumeric display.

10 As to claims 9 and 21, the readable medium and method as recited in claims 8 and 20, further, Toshiba discloses the alphanumeric display comprises a

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touch screen display (Page 1, Paragraph 3; Page 2, Satellite 5100-A741 Product Specifications).

11 As to claims 10 and 22, the readable medium and method as recited in claims 1 and 13, further, Manual discloses the memory size measured is an overall size of the writeable memory (Page 11, Paragraph 4). Also, it is well known in the notebook (computer) art to measure an overall size of the writeable memory.

12 As to claims 11 and 23, the readable medium and method as recited in claims 1 and 13, further, Manual discloses the memory size measured is an amount of available memory in the writeable memory **(When writeable memory is available (memory size is greater than 0), there is no indication on the display, so a user can keep programming the remote control. When the remote control displays “full” (memory size is 0), which is an indication as to the size of the writeable memory; See page 11, paragraph 4).**

Furthermore, it is well and widely used in notebook (computer) art to have a to measure a size of a writable memory **(the user can invoke the diagnostic routine by right clicking on the property icon of the notebook, the user can access the see the overall, occupied, and available memory of the notebook).**

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13 As to claims 12 and 24, the readable medium and method as recited in claims 1 and 13, further, it is well and widely used in notebook (computer) art to have a diagnostic routine is automatically invoked in response to a request to download data into the writeable memory **(notebook/computer invoke the diagnostic routine automatically when large memory requiring downloads /operations are performed and notify the user the amount of memory is insufficient/low).**

14 Claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manual in view of Toshiba and further in view of US patent of Dudek (5,523,800).

15 As to claims 2 and 14, the method as recited in claims 1 and 13, however, the combination of Manual and Toshiba does not expressly disclose the indication is presented by causing an LED of the universal remote control to blink. In the same field of endeavor, Dudek discloses an indication that causing an LED of a universal remote control to blink (Col. 16, lines 51-58).

It would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify the method for presenting a readable medium having instructions for presenting a size of a writeable memory of Manual and Toshiba, in order to have the indication is presented by causing an LED of the universal remote control to blink, because Dudek discloses the LED blinking to indicate correct or incorrect remote control operation termination and one of ordinary skill



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in the art recognizes the visual display of writable memory of Manual may be replaced by an LED that is arranged to blink to present a size of a writeable memory.

16 Claims 5, 17 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manual in view of Toshiba and further in view of US publication of Mulla et al. (20020162891).

17 As to claims 5 and 17, the readable medium and method as recited in claims 1 and 13, however, the combination of Manual and Toshiba does not expressly disclose the indication is presented by causing a speaker of the universal remote control to emit a sound. In filed of a writeable medium, Mulla et al., discloses an audible device to indicate to the user available memory (Page 4, Par. 0057, lines 13-16).

It would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify the method for presenting a readable medium having instructions for presenting a size of a writeable memory of Manual and Toshiba, by incorporating the sound indication for available memory size of Mulla et al., in order to have an indication that is presented by causing a speaker of the universal remote control to emit a sound, because one skilled in the art would recognize the memory indication of Manual may be replaced by any equivalent indicating means, which includes an audible sound that indicate the status of the readable memory as disclosed by Mulla et al.

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18 As to claims 25 and 26, the readable medium and method as recited in claims 5 and 17, however, the combination of Manual, Toshiba and Mulla et al., does not expressly disclose the sound comprises a voice.

It would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify the method for presenting a readable medium having instructions for presenting a size of a writeable memory of the combination of Manual, Toshiba and Mulla et al., by incorporating a voice to indication for available memory size, in order to have the indication that is presented by causing a speaker of the universal remote control to emit a sound to comprises a voice, because Mulla et al., discloses different audible tones and sound sequences may be used indication of the status of the readable memory and one of ordinary skill in the art recognizes that the speaker may be arranged to emit a voice as one of the audible sounds. Furthermore, voce have employed as indications means in different environments.

### **Claim Objections**

19 Claims 3, 4, 6, 7, 15, 16, 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

20 As to claims 3 and 15, the following is a statement of reason for the indication of allowable subject matter: the prior art fail to suggest limitations that

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the LED is blinked one of a predetermined number of times each being correlated to a different measurable memory size.

21 As to claims 4 and 16, the following is a statement of reason for the indication of allowable subject matter: the prior art fail to suggest limitations that the LED is blinked in at least one group of blinks, the group of blinks corresponding to one or more digits representative of measured memory size.

22 As to claims 6 and 18, the following is a statement of reason for the indication of allowable subject matter: the prior art fail to suggest limitations that the speaker is caused to emit the sound one of a predetermined number of times each being correlated to a different measurable memory size.

23 As to claims 7 and 19, the following is a statement of reason for the indication of allowable subject matter: the prior art fail to suggest limitations that the speaker emits at least one group of sounds, the group of sounds corresponding to one or more digits representative of measured memory size.

### **Conclusion**

24 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sisay Yacob whose telephone number is

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(571) 272-8562. The examiner can normally be reached on Monday through Friday 8:00 AM - 4:30 PM.

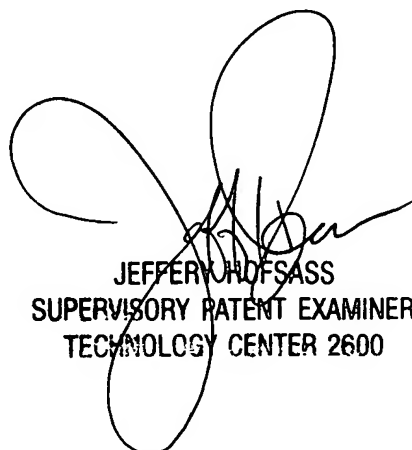
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery A. Hofsass can be reached on (571) 272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sisay Yacob

11/21/2006

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